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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/287,023	04/06/1999	DALE W. MALIK	BS100/176677	5759

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EXAMINER

NGUYEN, DUC MINH

ART UNIT PAPER NUMBER

2643

DATE MAILED: 10/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/287,023

Applicant(s)

MALIK

Examiner

Duc Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the calling line number associated with the second telecommunications account" in lines 21-22. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 10-12, 14-23, 26-27, 29, 32-33, 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Lesley (6,333,976).

Consider claims 10, 12, 34. Lesley teaches a method for using a communication to conduct a transaction with respect to a telecommunications account, comprising receiving the communication at the service switching point, the communication being associated with a CLID (subscriber's home residence telephone number; col. 6, ln. 48-50); causing the SSP to route the communication to the intelligent network element (SCP 20; col. 6, ln. 8-34); causing the intelligent network element to obtain a telecommunications account number (prepaid account) and a transaction amount from the communication, the account number corresponding to the telecommunications account with respect to which transaction is to be conducted in the billing system, the telecommunications account differing from a calling line number account associated with the calling line number (the abstract, ln. 22-31; fig. 4a-b, steps 99, 100, 102, 98; col. 6, ln. 46 to col. 7, ln. 36); in response to obtaining the telecommunications account number and the transaction amount, causing the intelligent network element to provide the telecommunications

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account number, the transaction amount, and the calling line number associated with the communication to the service control point (fig. 3; col. 9, ln. 34 to col. 10, ln. 25); in response to receipt of the telecommunications account number, the transaction amount, and the calling line number, causing the SCP to make an assignment of the telecommunications account number, the transaction amount, and the calling line number to a billing message (fig. 3; col. 7, ln. 37-63; col. 9, ln. 5-9; col. 10, ln. 13-25); and causing the billing system (40) to retrieve the billing message from the SCP, to note the assignment of the telecommunications account number, the transaction amount, and the calling line number to the billing message, and based on the assignment, to conduct the transaction in the billing system with respect to the telecommunications account associated with the telecommunications account number by crediting or debiting the telecommunications account by at least the transaction amount (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25).

Consider claims 15, 17. Lesley further teaches causing the SCP to carry out a validation whose result comprises a determination that the calling line number is authorized with respect to conduct of the transaction (col. 7, ln. 1-28).

Consider claim 16. Fig 2, col. 6, ln. 59-67 read on the limitations of claims 6, 16.

Consider claim 14. Col. 10, ln. 13-25 reads on the limitations of claims 7, 14.

Consider claim 11. The special access code is met by the 1-800 number (col. 5, ln. 38-54).

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Consider claims 18-23. Lesley teaches a method to conduct a transaction with respect to a telecommunications account (pre-paid account; col. 7, ln. 1-36) in the system, comprising obtaining a billing message generated as a result of a telecommunications service performed with respect to a calling line number (subscriber's home telephone number; col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); in response to obtaining of the billing message, the billing system (40) inherently makes a determination that the billing message includes an indication that a transaction is to be conducted with respect to a telecommunications account in the system, the telecommunications account differing from a calling line number account associated with the calling line number (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); and in response to the determination, the billing system (40) inherently conducts the transaction with respect to the telecommunications account (col. 7, ln. 37-63; col. 9, ln. 5-33; fig. 3; col. 10, ln. 13-25).

Consider claims 26-27, 29. Lesley teaches a method for execution of a transaction in the billing system between the calling line number account (col. 9, ln. 10-33) and one of the other accounts (prepaid account) to which the billing system has access, comprising providing that the billing message includes an indication for the execution of the transaction (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25), causing the billing system to make a recognition of the indication in the billing message (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); and in response to the indication in the billing message, inherently causing the billing system to execute the transaction between the calling line number account and the one of the other accounts (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25).

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Consider claims 32-33. Col. 9, ln. 29-33 reads on the limitations of claims 32-33.

Consider claim 35. Lesley teaches a method for executing a transaction, comprising receiving a communication associated with a calling line number (col. 9, ln. 10-33); obtaining a transaction amount from the communication (e.g., adding a pre-pay value to subscriber account; col. 9, ln. 10-33); coding the transaction amount and the calling line number into a billing message (fig. 3; col. 7, ln. 37-63; col. 9, ln. 5-9; col. 10, ln. 13-25); posting the billing message (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); obtaining the billing message, and decoding the transaction amount and the calling line number from the billing message (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); and crediting or debiting an account other than the account associated with the calling line number by the transaction amount (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25).

Consider claim 36. Lesley teaches a system for allowing a user to initiate a transaction and have the transaction conducted, comprising a service switching point (SSP 28) for receiving a communication from a user, and for obtaining and acting on instructions regarding the communication (see fig. 5); a service control point (SCP 20) for providing the instructions regarding the communication to the SSP, the instructions instructing the SSP to retrieve transaction information and to forward the transaction information to the SCP, for including the transaction information in a billing message by assigning the transaction information to at least a field of the billing message, and for posting the billing message for retrieval by a billing system (see fig. 5; col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); and the billing system (40)

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for retrieving the billing message (see fig. 3; col. 7, ln. 37-63; col. 9, ln. 5-9; col. 10, ln. 13-25), for inherently recognizing the transaction information in the billing message, and based on the recognition, for inherently conducting the transaction based on the transaction information (see fig. 5; col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 2-3, 4a-b; col. 10, ln. 13-25); and crediting or debiting an account other than the account associated with the calling line number by the transaction amount (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13, 24-25, 28, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lesley (6,333,976) in view of Resnick et al (6,185,545).

Consider claims 13, 28. Lesley does not teach charging a fee for the transaction.

Resnick teaches charging a fee for the transaction (col. 5, ln. 32-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Resnick into the teachings of Lesley, so that the



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telecommunications network can recoup expenses and earn some profits from providing services to the users.

Consider claims 24-25, 30-31. Lesley combines the invoice relates to the transaction conducted with respect to the telecommunications account (i.e., prepay account) and the invoice for the different telecommunications account (subscriber's home telephone account) (col. 9, ln. 5-9). Furthermore, the mere fact that a given structure is integral does not preclude its consisting of various elements, Nerwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. of Int. 1969). There is also a requirement that the unification or integration involve more than just mere mechanical skill. In re Murray, 19 C.C.P.A. (Patents) 739, 53 F.2d 541, 11 USPQ 155; In re Zabel et al., 38 C.C.P.A. (patents) 832, 186 F.2d 735, 88 USPQ 367. It appears that the unity or diversity of parts would depend more upon the choice of the manufacturer, and the convenience and availability of the machines and tools necessary to construct the telecommunication test system, than on any inventive concept.

#### ***Allowable Subject Matter***

7. Claims 1-7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

#### ***Response to Arguments***

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8. Applicant's arguments filed 8/28/02 have been fully considered but they are not persuasive.

Regarding the Lesley reference, applicant states "Lesley does not disclose any circumstance when the account differs from the calling line number associated with the calling line number account." In contrast to applicant's assertions, Lesley clearly teaches crediting or debiting an account (prepaid telecommunications account) other than the account (subscriber's home or office telephone account) associated with the calling line number by the transaction amount (fig. 2; col. 6, ln. 59-67; col. 7, ln. 1-16). Lesley further teaches "an appropriate billing record or other similar message is generated by the network to include the newly added prepay value to the subscriber's regular telephone bill under a line item such as "prepay services". (Col. 9, ln. 5-9). The regular telephone bill (i.e., subscriber's home or office telephone account) is the account associated with the calling line number. Fig. 2 clearly shows two different accounts.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., prepaying monetary amounts to an account of another customer or user) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Resnick is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to

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be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2D 1443 (Fed. Cir. 1992). In this case, Lesley teaches recharge or increasing prepaid telecommunications account balance (col. 9, ln. 34 to col. 10, ln. 25). Resnick also teaches recharge or increasing prepaid telecommunications account balance (col. 5, ln. 32-58). Since both references teach recharge or increasing prepaid telecommunications account balance, they are indeed in the same field of endeavor or analogous arts. Therefore, there is existing a strong prima facie case of obviousness and consequent non-patentability under 35 USC 103. Furthermore, *In re Ellis*, 177, USPQ 526 (CCPA 1973): while we find the diverse Patent Office classification of the references to be some evidence of “non-analogy,” and likewise find the cross-references in the official search notes to be some evidence of “analogy,” we consider the similarities and differences in structure and functions of the inventions disclosed in the references to carry far greater weight. Cf. *In re Heldt*, 58 CCPA 701, 706-07, 433 F. 2d 808,812, 167 USPQ 676, 679 (1970). Here the structural similarities and the functional overlap between pedestrian gratings and shoe scrapers of type shown by Trixner are readily apparent. We conclude that, at the very least, the arts to which the Schulz and Trixner patents belong are reasonably pertinent to the art with which the appellant’s invention deals. See *In re Antle*, 58 CCPA 1382, 1387, 444 F. 2d 1168, 1171-72, 170 USPQ 285, 287-88 (1971).

### ***Conclusion***

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is (703) 308-7527.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Kuntz, can be reached on (703) 305-4708.

**Any response to this final action should be mailed to:**

**Box AF**


Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 308-6306 or (703) 308-6296** (Group's Fax numbers)  
(703) 746-7251 (Examiner's Fax number, only for proposed amendment)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

October 2, 2002

  
**DUC NGUYEN**  
**PRIMARY EXAMINER**